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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/755,812	01/12/2004	Hao Xue	291010-00475	3131

3705 7590 03/23/2007
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EXAMINER

RAMAKRISHNAIAH, MELUR

ART UNIT	PAPER NUMBER
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2614

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/755,812

Applicant(s)

XUE ET AL.

Examiner

Melur Ramakrishnaiah

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-33, 35-41, 43 and 44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-33, 35-41, 43-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 29-33, 35-36, 37-41, 43-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. For example amended independent claim 29 recites: where in the mobile data device gives preference to various ones of the plurality of system preference criteria to create the ranking of available networks. Regarding this limitation, Applicant's specification does not have support for this, especially mobile data device creating ranking of available networks. All available evidence in applicant's specification points to non-existence of mobile data device creating ranking of available networks. As can be seen from the specification: Each mobile device includes a preferred roaming list (PRL) built into it, which assists the device to perform system selection and acquisition (page 2 lines 5-9). Further only place applicant specification talks about rank is in page 6 lines 25-28 which says: The PRL then ranks the priority of each system. This clearly shown that PRL with rank has already built into it user preferences for selection of networks as described in table 1. This in no way supports applicant's amended claim limitation such as mobile data device creating ranking of available networks. Therefore, ensuing office action proceeds with the understanding

Art Unit: 2614

that mobile data device already has PRL built in to it and based on that mobile data device selects the preferred network. Similar remarks apply to claim 37.

Claim Rejections - 35 USC § 103

3. Claims 29-33, 35, 37-41, 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Islam et al. (US2005/0090277A1, filed 10-24-2003, hereinafter Islam) in view of Almgren (WO 2004/066663A1, filed 12-3-2003).

Regarding claim 29, Islam discloses a method of a mobile data device to determine a network to acquire based on a plurality of system preference criteria stored in the preferred list on the mobile device, the method comprising the steps of: waiting until a new network needs to be acquired, choosing the network to acquire at the mobile data device based on the plurality of system preferences stored in the mobile device, and starting a search for the new network (paragraphs: 0004, 0006, 0012; 0060-0064; figs. 3-4).

Regarding claim 37, Islam discloses a mobile data device for acquiring one of plurality of networks based on plurality of system preference criteria stored in a preferred list on the mobile data device, characterized by means for: waiting until new network needs to be acquired, choosing the network to acquire at the mobile data device (102, fig. 1) based on the plurality of preference criteria stored on the mobile device, and starting a search for the new network (paragraphs: 0004, 0006, 0012; 0060-0064; figs. 3-4).

Islam differs from claims 29 and 37 in that he does not specifically teach: mobile data device gives preference to various ones of the plurality of criteria to create ranking of available networks.

However, Almgren discloses a roaming method which teaches the following: mobile device gives preference to various ones of the pluralities of system preferences criteria to create a ranking of available networks (reads on creating priority list, see abstract; page 14 lines 11-24 and fig. 2).

Thus it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: mobile device gives preference to various ones of the pluralities of system preferences criteria to create a ranking of available networks as this arrangement would facilitate connecting to the network based on the priority/ranking of networks as taught by Almgren, thus facilitating the user to connect to the best available network.

Regarding claims 30-33, 35, 38-41, 43-44, Islam further teaches the following: plurality of system preference criteria includes at least geographic information and data capability information, system preference criteria further includes information about whether each of the available network supports: data roaming for mobile data device (102, fig. 1), mobile IP, an always on device (note mobile device 102 is 3G capable and also prefers 3G network which implies it supports always on, paragraph: 0030), mobile stores a list of service features that mobile devices supports and plurality of system preference criteria that includes a list of services the network supports (paragraph: 0030, 0019, 0042-0043; 0053, 0061-0064), mobile device (102, fig. 1) includes means

Art Unit: 2614

(120, fig. 1) for storing a list of service features the mobile data device supports and plurality of system preference criteria further includes a list of services the network supports, mobile data device includes means for storing the plurality of system preferences criteria in a table (see table 1) with available networks (paragraphs: 0060-0064).

4. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Islam) in view of Almgren as applied to claim 29 above, and further in view of Russell (US 2004/0249915).

The combination differs from claim 36 in that he does not teach the following: choosing step can find no networks are available.

However, Russell teaches the following: choosing step can find no networks are available (fig. 8, paragraph: 0096).

Thus it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: choosing step can find no networks are available as this arrangement would facilitates the user to learn the no network is available for connection as taught by Russell, so that user is not kept in darkness as to availability of the network.

Response to Arguments

5. Applicant's arguments filed on 12-27-2006 have been fully considered but they are not persuasive.

Rejection of amended claims 29 and 37 which includes limitations of previous dependent claims 32 and 42 under 35 U.S.C 103(a) as being obvious over Islam et al.

Art Unit: 2614

(US2005/0090277A1, filed 10-24-2003, hereinafter Islam) in view of Almgren (WO 2004/066663A1, filed 12-3-2003): regarding rejection of claims, Applicant argues that "claims 29 and 37 have been amended to recite that the mobile device gives preference to various one of the plurality of system preferences criteria in order to create a ranking available networks". Applicant further argues that "contrary to the Examiner's assertion that there is no motivation or suggestion to combine the references as suggested by the Examiner. Moreover, it is noted that the Examiner has not provided a reason why one skilled in the art would combine the cited references". Contrary to applicant's allegation that has Examiner has not provided a reason why one skilled in the art would combine the cited references, Office action clearly sets forth the following as to why one skilled in the art would combine the cited references: Islam differs from claims 29 and 37 in that he does not specifically teach: mobile data device gives preference to various ones of the plurality of criteria to create ranking of available networks.

However, Almgren discloses a roaming method which teaches the following: mobile device gives preference to various ones of the pluralities of system preferences criteria to create a ranking of available networks (reads on creating priority list, see abstract; page 14 lines 11-24 and fig. 2).

Thus it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: mobile device gives preference to various ones of the pluralities of system preferences criteria to create a ranking of available networks as this arrangement would facilitate connecting

Art Unit: 2614

to the network based on the priority/ranking of networks as taught by Almgren, thus facilitating the user to connect to the best available network.

Art Unit: 2614

Applicant further argues that "the Applicant's respectfully disagree with the Examiner's position that Almgren's abstract discloses a mobile device that creates a ranking of networks. In Almgren, a preferred list of networks exists which are ranked previously and stored on the mobile device". Applicant further delves into Almgren's reference and quotes various things and argues that Almgren in other words, does not indicate that the mobile device creates a ranking of available networks. In fact ranking of available networks is static ... this is not the creation of ranking of available networks since the rankings of the mobile device of Almgren never change". Regarding this, Almgren system creates a ranking of preferred networks (i.e. priority of networks) which is quite similar to what applicant's specification supports in that as noted earlier under 35 U.S.C 112 rejection of applicant's claims. As can be seen from applicant's specification: Each mobile device includes a preferred roaming list (PRL) built into it, which assists the device to perform system selection and acquisition (page 2 lines 5-9). Further only place applicant specification talks about rank is in page 6 lines 25-28 which says: The PRL then ranks the priority of each system. This clearly shown that PRL has already built into it user preferences for selection of networks as described in table 1. This in no way supports applicant's amended claim limitation such as mobile data device creating ranking of available networks. In view of this, Almgren disclosure reads on applicant's amended claims in combination with Islam. Therefore rejection of claims 29-33, 35-41, 43-44 is maintained as set forth in the office action.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

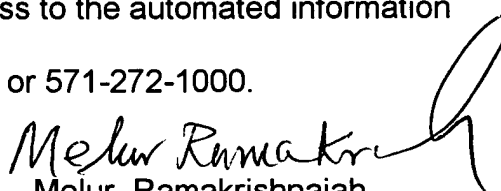
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (571)272-8098. The examiner can normally be reached on 9 Hr schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curt Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2614

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Melur Ramakrishnaiah
Primary Examiner
Art Unit 2614